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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,675	07/09/2001	Nicholas Paul Elliott	UDL 2 0011	2251

7590 09/07/2004

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EXAMINER

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/07/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,675

Applicant(s)

ELLIOTT ET AL.

Examiner

Paula W Klimach

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:
System for protection of goods against counterfeiting.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7 and 11 rejected under 35 U.S.C. 102(e) as being anticipated by Coppersmith.

Coppersmith discloses a system for protection of goods against counterfeiting (title), characterized in that a security code is applied to the goods (column 4 lines 8-10). The security code having been derived by means of a predetermined encryption algorithm from the public data applied to the goods and plurality of private data sets held by verifier (column 2 lines 42-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith et al (6,069,955).

In reference to claims 1, Coppersmith discloses a system for protection of goods against counterfeiting (title), and therefore a system for verifying the authenticity of goods. Coppersmith discloses a system and method that comprises a security code is applied to the goods (column 4 lines 8-10), said security code having been derived by means of a predetermined encryption algorithm from said public data applied to the goods and a plurality of private data sets held by a verifier (column 2 lines 42-67); and, upon receiving a request for verification, each private data set is entered into said predetermined encryption algorithm together with the public data applied to the goods, the verification codes is compared with the security code applied to the goods to assess the authenticity of goods (column 2 lines 57-67 and column 3 lines 31-58).

Although Coppersmith discloses that the manufacturer possessing the private keys and corresponding public keys and therefore verification codes (column 3 lines 35-36), Coppersmith does not expressly disclose organizing these verification codes in a list of verification codes.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to generate a list of verification codes for finding the authenticity in the system of Coppersmith. One of ordinary skill in the art would have been motivated to do this because a list is a convenient method of organizing the security codes.

In reference to claims 3, 8 and 12, wherein the public data (8) includes a batch number. Coppersmith indicates that the product could be a container of items, and therefore a batch (column 2 lines 44-45).

In reference to claims 4, 9, and 13, wherein the public data (8) includes date information (column 4 lines 26-27).

In reference to claim 5, wherein the private data (12) includes an item number (column 4 lines 26-27).

In reference to claims 6, 10, and 14, wherein said public data (8) and said security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (column 4 lines 19-22 and lines 58-59).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith as applied to claim 1 above, and further in view of Tran (5,864,665).

Coppersmith does not disclose a system wherein the verifier maintains a log of requests for verification and, upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

Tran discloses a method of auditing login activity (abstract), where login activity is used to verify that users are who they say they are, by maintaining a record of valid login (column 7 lines 54-60 and column 8 lines 44-47). This information may generally used for verification upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to maintain a log of verification requests as in Tran in the system of Coppersmith. One of ordinary skill in the art would have been motivated to do this because the log would provide a record of the goods needing verification.

Conclusion

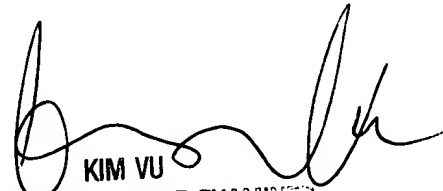
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The 2100 Tech center will move to Carlyle in October 2004. The new telephone number for the receptionist is (571) 272-2100. The examiner's new telephone number will be (571) 272-3854.

PWK
Friday, September 03, 2004


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100